

Application No.: 10/518324  
Docket No.: BA9308USPCT

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AUG 16 2007

REMARKS

## I.

Applicant notes the request in the Amendment dated July 10, 2007 that the Examiner consider application No. 10/518325 as listed in the Information Disclosure Statement for this application. This request was not addressed in the Office Action. Inasmuch as pending applications can be pertinent to patentability, Applicant respectfully requests consideration of that document as a pending application. As noted in the Information Disclosure Statement, that application is a national filing of WO 04/011453. Moreover, Applicant notes that Application No. 10/518325 published on September 29, 2005 as 2005/0215798.

## II.

In the Office Action, the lack of unity requirement was deemed proper and the finality indicated in the previous Office Action was maintained. The Office Action maintained *inter alia* that the special technical feature of Group I is a benzo[1,3]oxazinone ring and is different from the special technical feature of Group II; and with regard to Applicant's observation that all Js were included in Group II, that election of a single disclosed species is a standard procedure when an invention is very broad an unsearchable. The Office Action indicated that Applicant had to delete the non-elected subject matter (e.g., from claims 8 and 12) and delete claims 10, 11, 20 and 21; or file a petition for the restriction requirement.

Applicant respectfully points out that again despite the "differences" noted in the Office Action (as well as previous Office Actions) all of the original claims still are linked by a single general inventive concept: the process sequence represented by (1), (2) and (3) in original Claim 1 that can be used in connection with the preparation of fused oxazinones as recited in that claim (a sequence involving *inter alia* certain common structures and mole ratio aspects as described in the Response dated February 8, 2007).

Applicant also acknowledges the practice of requiring a provisional election of a single species under certain circumstances, at least for applications filed under 35 U.S.C. 111 (see e.g., MPEP 803.02). However, Applicant also notes that for such applications, where different species fall within the scope of a generic claim, an allowable generic claim may link a reasonable number of species embraced thereby (see e.g., MPEP 806.04). Moreover, Applicant notes with regard to claims 10, 11, 20 and 21, that claim 12 would appear to be a subcombination of combination claim 10 and claim 15 would appear to be a subcombination of combination claim 20 (see MPEP 806.05(c)).

In order to clarify the restriction requirement in this application, the undersigned attorney and Dr. Wonpyo Hong (an employee involved with patent matters at E. I. du Pont de Nemours and Company, the assignee of this application) discussed the requirement with the Examiner in telephone conferences on August 13, 2007. The courtesy accorded the undersigned attorney and Dr. Hong during the telephone conferences is acknowledged and

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appreciated. In the conferences, it was noted that Claim 9 is included in Group I even though it recited that Y is N (i.e., Claim 9 pertained to certain compounds where "J" was a pyrazole rather than a pyrrole). Upon consideration of this, the Examiner indicated that he would consider extending the scope of the searched compounds to those where J was a pyrazole as well as those where J is a pyrrole. The Examiner noted however that other aspects of the claims would still require attention.

In order to expedite prosecution of this application, Claim 12 has been amended to recite that J is a pyrrole ring or a pyrazole ring (each optionally substituted as indicated in the claim).

### III.

In the Office Action claims 3-4, 7-9 and 12-19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for using the phrase "optionally including" at line 15 of Claim 12. The Examiner recommended use of the phrase "optionally with".

Applicant notes that the phrase "optionally including" is among the language deleted from the definition of J as a result of the amendment to Claim 12. However, Applicant also notes that a similar use of that phrase as preset in the definition of G; and in order to expedite prosecution of this application, the definition of G in Claim 12 has been amended to include the phrase "optionally with".

### IV.

In the Office Action claims 13 and 16 were rejected under 35 U.S.C. 112, second paragraph, as being unclear for using the phrase "wherein the pyridine compound is selected from the groups consisting of pyridine, quinoline, isoquinoline and pyridine substituted with alkyl....". The Office Action noted that Claim 12 recites "in the presence of pyridine compound; not in the presence of quinoline or isoquinoline compounds."

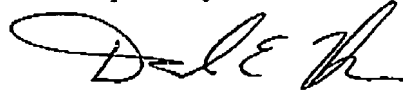
In order to expedite prosecution of this application, claims 4, 12, 13, 15, 16 and 19 have been amended; and among the amendments to those claims is the substitution of "Formula 3 compound" for the term "pyridine compound". Applicant notes page 8, lines 24-34 in connection with claims 12 and 15 and page 45, lines 5-10 in connection with claims 13 and 16.

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In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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